

Remarks

Claims 11 – 16, 20 and 21 were rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement, the rejection asserting only that the original disclosure failed to describe the “gripping panels [extend] parallel to one another and [being] uniform in width along an axial portion of the gripping feature.” This rejection is respectfully traversed.

To the extent that the rejection under 35 U.S.C. §112, first paragraph, is based on lack of support for “the specificity of the two gripping panels being extending parallel to one another,” without acquiescing in the propriety of such observation, it is believed that this observation is now moot in view of the cancellation of that portion of the language of claim 11, from which all other pending claims depend. To the extent that the rejection under 35 U.S.C. §112, first paragraph, is also based on the lack of support for the limitation in claim 11 with respect to “the space (S) between said gripping panels being uniform in width along an axial length portion of said gripping feature,” the rejection is respectfully traversed.

Fig. 15 of the drawing clearly shows that the space between the gripping panels 48d, 48e is uniform for almost the entirety of the axial extent of such gripping

panels. Further, Fig. 11 shows no taper with respect to any axially extending portion of the gripping panels 48d, 48e, and any such taper would have been indicated by the presence of additional lines, for example, as would be seen from a point above a pyramid.

Accordingly, reconsideration and withdrawal of the rejection of claims 11 – 16, 20 and 21 under 35 U.S.C. §112, first paragraph, are respectfully requested.

Claims 11, 12 and 21 were rejected under 35 U.S.C. §103(a) as being unpatentable over Holmes (D308,167) in view of Krishnakumar (5,472,105) and further in view of Slat et al. (5,688,572). This rejection is respectfully traversed.

To begin with, it is submitted that the tortured reconstruction of the device of Holmes in view of the teachings of Krishnakumar and Slat et al. is a reconstruction that does not even qualify as a proper *prima facie* obviousness rejection under In re Fine, 837, F.2d 1071, 5 USPQ 2d1596 (Fed.Cir. 1988), where the court stated that “substitution of one type ... for another in the system of ... would have been within the skill of the art,” was improper because it was nothing more than a “bald assertion” that was offered without support or explanation for the conclusion. Id. 5 USPQ 2d at 1599.

Even assuming, *arguendo*, however, the propriety of the reconstruction of the Holmes device in view of the teachings of Krishnakumar and Slat et al. as a

proper *prima facie* obviousness rejection under 35 U.S.C. §103(a), it is respectfully submitted that such rejection has been overcome by the enclosed Declaration of co-inventor Zhang under 37 CFR §1.132, which sets forth his opinion, with ample supporting qualifications, that it would not have been obvious to one of ordinary skill in the art to construct the container of Holmes from a PET-based cylindrical preform such as that taught by Slat et al. because of the unduly large dimensional changes that the Slat et al. preform would have to undergo; in that regard, these changes in a preform that includes a PET-based material would lead to unacceptable appearances in the surface of the container in the regions undergoing the necessary change in dimension from the dimension of the preform of Slat et al. to the container of Holmes. Further, Krishnakumar does nothing to overcome this deficiency in the combined teachings of Holmes and Slat et al. in trying to produce a container of the type taught by Holmes from a cylindrical preform of the type taught by Slat et al., especially since Krishnakumar teaches a container with a gripping feature in the cylindrical body of the container rather than in its tapered neck portion.

Accordingly, reconsideration and withdrawal of the rejection of claims 11, 12 and 21 under 35 U.S.C. §103(a) as being unpatentable over Holmes in view of Krishnakumar and further in view of Slat et al. are respectfully requested.

Claims 11, 12, 13 and 16 were rejected under 35 U.S.C. §103(a) as being unpatentable over Gatten (4,671,412) in view of Krishnakumar '105 and further in view of Slat et al. This rejection is also respectfully traversed.

To begin with, it is respectfully submitted that the tortured reconstruction of the device of Gatten in view of the teachings of Krishnakumar and Slat et al. does not qualify as a proper *prima facie* obviousness rejection under Fine, supra.

Further, even assuming, *arguendo*, the propriety of the reconstruction of the Gatten article in view of the teachings of Krishnakumar and Slat et al. to be a proper *prima facie* obviousness reconstruction, it is respectfully submitted that this rejection has also been overcome by the enclosed Zhang Declaration under 37 CFR §1.132.

This declaration also sets forth Mr. Zhang's opinion that it would not have been obvious to one of only ordinary skill in the relevant art to attempt to manufacture the Gatten container from a cylindrical preform such as that taught by Slat et al.

because of the very large changes in dimension that would have been necessary in going from the preform of Slat et al. to the container of Gatten, which would have undesirably changed the surface appearance of the container in the region undergoing such a change in dimensions.

Accordingly, reconsideration and withdrawal of the rejection of claims 11, 12 and 13 under 35 U.S.C. §103(a) as being unpatentable over Gatten in view of Krishnakumar '105 and further in view of Slat et al. are respectfully requested.

Claims 11, 12, 13 – 16 and 20 were rejected under 35 U.S.C. §103 as being unpatentable over Leary et al. (D250,392) in view of Krishnakumar '105 and further in view of Slat et al. This rejection is also respectfully traversed.

Leary, as a design patent and as admitted by the Examiner in the statement of the rejection, fails to make important claim limitations with respect to an innermost layer of the container being PET, and it also fails to disclose a container that meets the dimensional limitations of the claims at issue. Leary is also deficient in failing to teach that the space between the gripping panels is uniform in width along a substantially axial length portion of the gripping feature, as is clear from Fig. 4 of its drawing. Any change in this important feature of the Leary et al. container (and its importance to Leary is underscored by the fact that it is shown in solid line,) would not have been obvious to a skilled artisan because Leary et al., to the extent that it contains any relevant teachings, "teaches away" from the reconstruction that was indulged by the Examiner in support of the rejection of claims 11, 12, 13 – 16 and 20; this reconstruction, accordingly, is impermissible under W.L. Gore & Associates Inc. v. Garlock, Inc., 721 F.2d. 1540, 220 USPQ 303

(Fed.Cir. 1983). As noted by Gore, when one proceeds contrary to the accepted wisdom of the prior art, which is the case in connection with the claims at issue, claims may be found to be valid over prior art references; otherwise, "one would fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher." Id., 220 USPQ at 312, 13.

It is also respectfully submitted that the tortured reconstruction of the article of Leary et al. in view of the teachings of Krishnakumar '105 and Slat et al. does not qualify as a proper *prima facie* obviousness rejection under Fine, supra; the steps involved in modifying the product of Leary et al. in view of the teachings of Krishnakumar and further in view of the teachings of Slat et al. are in the category of "bald assertions," and this is improper. Fine, 5 USPQ 2d at 1599.

Claim 21 was rejected under 35 U.S.C. §103(a) as being unpatentable over the rejections of anyone of Holmes, Gatten, and Leary as set forth above, and further in view of Krishnakumar (5,279,433). This rejection is respectfully traversed.

To begin with, it is respectfully submitted that the statement of the rejection of claim 21 is inadequate because it fails to take into account the teachings of Krishnakumar '105 and Slat et al., which were used in support of each of the 35 U.S.C. §103(a) rejections of claim 11, from which claim 21 depends. Thus, to the extent that there is any proper basis for the rejection of claim 21, the rejection

should have been stated that it is unpatentable over the rejections of any one of Holmes, Gatten and Leary, as set forth above, in view of Krishnakumar '105 and Slat et al., and further in view of Krishnakumar '433. In any case, this rejection is respectfully traversed.

To begin with, it is respectfully submitted that claim 21, as a claim that depends from claim 11, is patentable with claim 11 for the reasons set forth above in support of the patentability of claim 11 over each prior art reconstruction that was indulged in support of the rejection of claim 11.

It is also respectfully submitted that the rejection of claim 21, relying as it does on a combination of the teachings of no less than 4 prior art references, is clearly an impermissible "hindsight" rejection. In re Fritch, 972 F.2d 1260, 23 USPQ 2d 1780, where the court, quoting from Fine 837 F.2d at 1075, 5 USPQ 2d at 1600 stated "[o]ne cannot use hindsight reconstruction to pick and chose among isolated disclosures in the prior art to deprecate the claimed invention." Id. 23 USPQ 2d at 1784.

Accordingly, it is respectfully submitted that claim 21 defines patentably under 35 U.S.C. §103(a) over any proper combination of the teachings of Holmes, Gatten or Leary in view of Krishnakumar '433, even if the teachings of Krishnakumar '105 and Slat et al. are taken into account.

It is also respectfully submitted that Krishnakumar '105, in addition to not teaching any gripping feature in a tapered neck of a container, does not teach a container with a gripping feature that is less than 2-1/2 inch (even in a body portion of the container), as asserted by the Examiner in each of the statements of rejection. In that regard, the calculation of the spacing taught by Krishnakumar between its gripping panels, which was based on the assumption that the relevant dimension from Figs. 3 and 5 is the dimension  $d_4$ , is not well-founded; in that regard, the dimension  $d_4$  is the dimension to the valleys between the ribs 39, whereas the relevant portion of the container contacted during gripping of the container, at best, would be the tips or peaks of such ribs 39. In any case, while Krishnakumar '105 does not set forth a dimension with respect to the tips of the rib 39, Fig. 4 indicates that the gripping space is defined by the tip of the transfer rib 38, which appears from Fig. 4 to be spaced at a distance  $d_1$  from the outside diameter of the article. From the specification, at Fig. 5, lines 23 – 27,  $d_1$  is no more than 0.35 – 0.65 inches, and, with an overall bottle diameter of 4.0 inches, the spacing between the tips of the ribs 38 would be at least 2.7 inches, which fails to meet this limitation of claim 11. This point of novelty at the claims at issue is important to the gripping of a container with at least a 4.0 inch outside diameter by individuals with smaller hands for the reasons set forth in the specification of this

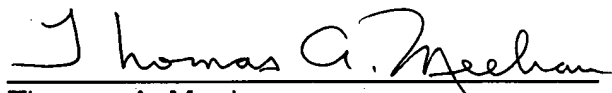


application at page 2, lines 14 – 17. This advantage in the product of the rejected claims is more than sufficient to overcome even a proper *prima facie* obviousness rejection, and lends patentability to all of the claims at issue in this application over all bases set forth in the rejections of them.

It is also respectfully submitted that cases such as In re Rose, 105 USPQ 237 (CCPA 1955) and In re Tanczyn, 44 CCPA 704, which were cited for the proposition that “[a] change in size/proportion is generally recognized as being within the level of ordinary skill in the art,” are only sufficient, at best, to support a conclusion of the claimed invention as *prima facie* obvious from the prior art. However, as is clear from In re Rinehart, 531 F.2d 1048, 189 USPQ 143 (CCPA 1976), it is clear that the concept of *prima facie* obviousness is rebuttable because it is only a legal conclusion and not a fact. Id. 189 USPQ at 147. In this case, it is respectfully submitted that satisfactory, rebuttal evidence to rebut the *prima facie* obviousness of the claims at issue, if proper, which is not conceded, is contained both in the enclosed Declaration of Mr. Zhang under 37 C.F.R. §1.132, with respect to rejections based on the Holmes and Gatten references, and is contained within the specification of this application, with respect to the container of Fig. 9 – 16, at page 8, lines 8 – 19, which indicates that the prior art, collectively, does not teach that the result of the claims at issue is achievable.

Accordingly, it is respectfully submitted that Applicants have responded in a fully satisfactory manner to all matters at issue in this application, and that this application is in condition for allowance. Reconsideration and allowance of this application at an early date are, therefore, respectfully requested.

Respectfully submitted,

A handwritten signature in black ink, reading "Thomas A. Meehan". The signature is written in a cursive style with a large initial "T".

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